Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte FELIX L. SORKIN

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Appeal No. 2004-1269
Application No.09/649,157

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ON BRIEF

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Before, PAK, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 39 and 40, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a post-tension anchor system for maintaining the tendon of the post-tension system in a corrosion resistant state. An understanding of the invention can be derived from a reading of exemplary claim 39, which is reproduced below.

39. A post-tension anchor system comprising:

an anchor body having a polymeric encapsulation extending therearound, said encapsulation having a tubular portion integrally formed therewith and extending outwardly from one end of said anchor body, said anchor body having a wedge-receiving cavity formed therein, said tubular portion having an intetlock area extending around an exterior surface thereof, said interlock area comprising a protrusion extending outwardly and around said tubular portion adjacent and end of said tubular portion opposite said anchor body;

a tendon affixed within said wedge-receiving cavity of said anchor body, said tendon having a sheathed portion and an unsheathed portion;

a seal member affixed to an end of said tubular portion opposite said anchor body, said seal member extending around said sheathed portion of said tendon in generally liquid-tight relationship therewith, said protrusion engaging an indentation formed on an interior surface of said seal member, said seal member comprising:

a first annular portion extending around said tubular portion at said end; and

a second annular portion extending outwardly from said first annular portion, said second annular portion being in liquid-tight relationship with said sheathed prtion of said tendon, said second annular portion having a diameter smaller than a diameter of said first annular portion, said second annular portion extending outwardly of said end of said tubular portion, said seal member being formed of an elastomeric material, said tubular portion having a length of greater than four inches extending outwardly of said anchor body; and

a plurality of wedges in interference-fit relationship with said unsheathed portion of said tendon within said wedge-receiving cavity of said anchor body.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wlodkowski et al. (Wlodkowski)	4,363,462	Dec. 14, 1982
Sorkin	5,839,235	Nov. 14, 1998

Claims 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin alone or in a separate rejection in view of Wlodkowski.

We refer to the brief and the answer for a complete exposition of the opposing positions of appellant and the examiner.

OPINION

Upon careful review of the respective positions advanced by appellant and the examiner with respect to the rejections that are before us for review, we find ourselves in agreement with appellant's viewpoint in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection.

The examiner acknowledges that the "protrusion and indentation relationship in the connection of the seal 12 and the tubular portion 16 of Sorkin" (final rejection, page 2) are not

the same as the relationship between the anchor body integrally formed tubular portion and the seal member as recited in appealed claims 39 and 40. In this regard, the examiner (final rejection, page 2)[1] argues, as a general proposition, that:

> [t]he interchangability of protrusions and indentations on tubular members which are to be coupled, as well as which tubular member is to be the "female" element and which is to be the "male" element, are mechanical equivalents well within the purview of one of ordinary skill in the art. In view of this, it would have been obvious to modify '235 whereby the seal 12 had a portion large enough to fit over tubular portion 16 as well as to have a protrusion on either the outer surface of the tubular portion or the inner surface of the seal member.

Alternatively, the examiner (final rejection, page 3) maintains that:

> Wlodkowski et al is provided to teach that locating a seal over the end of the tubular portion is well known. In view of this teaching, it would have been obvious to modify '235 whereby his seal 12 is located over the tubular portion, such providing a more effective seal.

However, the examiner has not established, on this record, how that proposed modified structure of Sorkin corresponds to appellant's claimed structure which includes a seal member having: (1) a specifically defined first annular portion that extends around the tubular member where the seal member is

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[1] At page 3 of the answer, the examiner refers us to the final rejection for the examiner's statement of the rejections.

affixed to an end potion of the tubular member and (2) a smaller diameter second annular portion that extends outwardly from the first annular portion.

Thus, even if we could agree with the examiner's proposed modification of Sorkin, the examiner has not fairly explained how that modified system of Sorkin would correspond to the here claimed anchor system including the specific claimed geometry of the seal member portions. Nor has the examiner reasonably explained why one of ordinary skill in the art would have been led to further modify the anchor system of Sorkin with or without the teachings of Wlodkowski to employ a seal member having the specific structural characteristics set forth in appealed claims 39 and 40. We note for example that Sorkin (column 6, line 53 through column 7, line 9 and drawing figures 9 and 10) discloses alternative embodiments wherein a trumpet (tube) portion of the post-tension anchor system is snap fitted within the corrosion protection tube. However, in those embodiments wherein Sorkin employs a protrusion (112) on the exterior of the trumpet (tube) portion, the corrosion protection tube has not been shown to have the here claimed seal member geometry based on the examiner's proposed modification in a manner so as to arrive at the here claimed subject matter. In this regard, we note that the

examiner has not established with any particularity how a specific proposed modification of any of the several particular apparatus embodiments of Sorkin would have been suggested by the applied prior art so as to result in the claimed structure.

Accordingly, on this record, the rejections fail for lack of a sufficient factual basis and analysis by the examiner upon which to reach a conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

CONCLUSION

The decision of the examiner to reject claims 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and to reject claims 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Sorkin in view of Wlodkowski is reversed.

REVERSED

Chung K. Pak Administrative Patent Judge	)
PETER F. KRATZ Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY T. SMITH Administrative Patent Judge	)

PFK/jlb

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